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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2175

13

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,661

Applicant(s)

TSUJI, MASAOKI

Examiner

Sam Rimell

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 5: Claim 5 has been amended to include the phrase "the alternating period being based on a number of data sectors corresponding to the subcode component data prior to the alteration. The principle of the alternating period being based on or influenced by the number of data sectors in considered new matter in relation to the original disclosure.

The only portion of the original disclosure that appears to discuss these features is page 48, lines 14-19, which state the following:

"As mentioned above the subcode P data is data which toggles every 75/4 seconds between the High state and the Low state by counting sectors based on the original data of the subcode P data. The period of the toggling is 75/2 seconds." (emphasis added).

This statement from the specification indicates that the sectors of original subcode P data are counted as part of the toggling process. The period is thus a complete toggling cycling from High to Low. However, the specification does not go any further, by suggesting that the toggle period is altered, influenced or otherwise derived from the resulting count of sectors.

In view of these considerations, the features recited above which have been amended into claim 5 are considered to be new matter.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawamura et al. (U.S. Patent 6,075,920).

Claim 1: FIG. 1 of Kawamura et al. discloses a control unit (20) which controls a first generating portion (9) which generates time code information. The control unit (20) itself is a second generating portion that generates non-time-code information, such as sector number, copyright management information, track number, application ID number, application information and layer information (see right arrow extending from control unit). The time code information and non-time-code information are each components of subcode that are entered into a subcode generator (11) which outputs subcode. The control unit maintains controls over the output of the time code information and non-time-code information, and thus can be read as a selecting portion which selects output. The system incorporates first and second commands in a number of different respects. First, the table of Fig. 6 incorporates meta data that controls the structure of the subcode. The meta data are thus considered to be commands that control the structure of the subcode. Secondly, the control unit also communicates over separate channels (see the left and right arrows from control unit) and thus creating separate first and second commands.

Claim 2: The second generating portion outputs six types of data, and can thus be said to comprise a plurality of generating portions.

Claim 3: See remarks for claim 1. Also note table of FIG. 6, which is a data table in memory having separate table locations (memory areas) for metadata (commands) associated with the time code data and non-time code data.

Claim 4: See claims 2-3.

Remarks

Applicant's amendments have overcome all previous grounds of rejection under 35 USC 112, second paragraph.

With respect to claim 1-4, applicant's arguments have been considered, but appear to be generic discussions of the content of the claims and the Kawamura et al. reference without consideration of the points raised in the office action. For example, applicant states in the response at page 8, second paragraph:

"Applicant does not find disclosure or suggestion by the cited art, however, of automatic generation of subcode component data which indicates the time information separately from the automatic generation of additional subcode component data which indicates information other than the time information."

However, both of these features were discussed explicitly in the first office action, with the discussion repeated herein. Examiner pointed out that the system of Kawamura et al. had a time code generation portion (9) and a second generating portion (20—also schematically illustrated by right most arrows from the control unit) that generates non-time code information.

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Examiner maintains that all of the features recited in claim 1-4 are fully taught by Kawamura et al.

Claim 5 has been rejected under a new basis of rejection involving 35 USC 112, first paragraph. The rejection derives from a suggestion in claim 5 that the alternating period of toggling is based on or derived from a number of subcode sectors that existed prior to toggling. Examiner has reviewed and discussed a specific section of the specification (page 48, lines 14-19) that appear to be most closely related to these features but which do not fully support the specific claim language. Accordingly, claim 5 has been rejected under 35 USC 112, first paragraph for raising an issue of new matter.

This office action is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
Art Unit 2175